Supreme Court, U.S.
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NO. 98-728

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1998

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DRILTECH, INC.,

PETITIONER,

v.

REEDRILL CORPORATION,

RESPONDENT

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ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

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# BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Theodore Stevenson, III*
David H. Judson
Danny S. Ashby
HUGHES & LUCE, L.L.P.
1717 Main Street, Suite 2800
Dallas, Texas 75201
(214) 939-5500

ATTORNEYS FOR RESPONDENT
*Counsel of Record

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## QUESTIONS PRESENTED

I. Does this Court's decision in *Markman* require a district court to limit a term in a patent more narrowly than its plain meaning when the Petitioner stipulated before the district court that the plain meaning should control?

II. Did the Federal Circuit properly reject Petitioner's assignment of error to a jury instruction that Petitioner requested and that the district court gave to the jury without objection?

## STATEMENT PURSUANT TO RULE 29.6

The only parties to this action are those listed in the caption. The parent companies and nonwholly owned subsidiaries of Reedrill Corporation that have issued shares to the public are:

Svedala, Inc.

The following entity has an interest in the outcome of this case:

Reedrill Enterprises, Inc.

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## I. STATEMENT OF THE CASE

### A. Summary Of Opposition

Petitioner Driltech, Inc. (Defendant below) seeks to challenge a patent claim construction that it requested from the district court, and that the district court gave to the jury. At trial, Petitioner urged the district court to instruct the jury to give the words in the claim their plain meaning. Despite the fact that Petitioner never objected to, and in fact invited this claim construction, Petitioner now contends that the district court committed reversible error by giving the "plain meaning" instruction. Unsurprisingly, the Federal Circuit affirmed the judgment of infringement without opinion.

Petitioner argues that "[w]here a jury is instructed to use the 'plain meaning' for a term that has a particular meaning in a patent, *Markman II* is violated." If the Court were to grant *certiorari* in this case, it would never reach the issue of claim interpretation, because Petitioner invited the trial court to give a "plain meaning" jury instruction and repeatedly waived its objections to that instruction. *Markman* did not overrule the long-standing law of invited error, change the procedure to preserve objections to a jury charge, or repeal the command in Fed. R. Civ. P. 51 that "[n]o party may assign as error the giving or failure to give an instruction unless that party objects thereto."

This case does not present issues worthy of review by *certiorari*. Neither the district court nor the Federal Circuit issued a published, precedential opinion in this case. There is no conflict between circuits. The answer to the question presented here -- whether a private litigant waives its objection to a jury instruction on claim interpretation by inviting the district court to give that very instruction -- is a foregone conclusion that does not warrant *certiorari*.

## B. Proceedings Below

Respondent, Reedrill Corporation, manufactures rotary blasthole drilling rigs. Reedrill is the owner of United States Patents 4,128,135 and 4,194,419 (the '135 and '419 Patents) that cover rotary blasthole drilling technology. The '135 Patent discloses and claims a combination drill pipe handling and storage apparatus comprising three elements: a pipe storage rack, a pair of pipe holding wrenches, and a hydraulically operated breakout wrench. The '419 Patent covers just the hydraulically operated breakout wrench.

Reedrill sued Driltech for infringement of the '135 and '419 patents in the United States District Court for the Eastern District of Texas. The district court entered a partial summary judgment holding that Driltech's rotary blasthole drills infringed the '419 patent. The parties proceeded to a jury trial on the issues of 1) infringement of the '135 patent, 2) willfulness, 3) Driltech's defenses (validity of the patents and laches), and 4) damages.

Before trial, Driltech submitted a Brief on Interpretation in which it unequivocally told the district court that the "plain meaning" of the claim language should control. Driltech further told the district court that it did not need to conduct a *Markman* hearing to consider whether the claims of the patent should be interpreted differently than their plain meaning. Driltech made the following statements to the district court:

- "No *Markman* hearing is required."
- "Defendants [sic] agree that the '135 patent can be interpreted from the language of the patent itself with some reference to ordinary usage as described in a dictionary."

- "Since the plaintiff and defendant agree that the 'plain language' of the patent is sufficient, the Court need not conduct any *Markman* hearing to consider extrinsic evidence."[1]

During the course of fashioning the jury charge, the district court held numerous charge conferences with counsel before issuing its final draft of the charge.[2] During a colloquy regarding how Reedrill's Rule 50 motion would affect the jury charge, Driltech's lawyer told the district court that:

> With respect to the . . . moveable gate, it seems to me that based on all of the testimony, that's an issue for the jury. They may decide or not decide what the -- what the plain meaning of those words are.[3]

Driltech filed written objections after the district court issued its final draft of the charge. Nowhere in these objections did Driltech mention the plain meaning instruction about which it now complains.[4] The district court also received oral objections to the charge after reading it to the jury. Driltech did not orally object to the district court's plain meaning instruction either.[5]

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1 These statements appear in the appellate record at A01216.

2 Appendix E to Petitioner's Brief.

3 Trial Transcript at 1079.

4 Appendix E to Petitioner's Brief.

5 Trial Transcript at 1208.

After a five-day trial, the jury returned a verdict 1) that Driltech's rotary blasthole rigs infringed the '135 patent, 2) that Driltech's infringement of both patents was willful, 3) rejecting Driltech's defenses of invalidity and laches, and 4) awarding actual damages of $10,130,934 for infringement of both the '135 and '419 patents.

The district court entered judgment of infringement against Driltech. The district court further found that Driltech's willful infringement warranted enhanced damages in the amount of $2,938,529. The district court also held that this was an exceptional case pursuant to 35 U.S.C. § 285 and awarded Reedrill its attorneys' fees.

After the trial court entered judgment, Driltech moved for judgment as a matter of law and, in the alternative, a new trial. Driltech alleged that the trial court erred when it instructed the jury that it should give the term "gate," as used in the patent claims, its plain and ordinary meaning. The trial court held that Petitioner had waived any objections[6] to its jury instructions on claim interpretation:

> [The Court] created several draft versions of the charge and had multiple charge conferences with both attorneys present. At each stage of the process, the

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6 Driltech did submit proposed definitions of a number of claim terms in its draft jury charge submitted months before trial in the Joint Pretrial Order. Driltech, however, never referred to or drew the district court's attention to these definitions, which were part of a large stack of pretrial materials. The district court, in denying Driltech's motion for a new trial, held that these proposed jury instructions submitted with the Joint Pretrial Order did not preserve Driltech's objections. "Counsel cannot bury a proposed jury instruction in instructions submitted to the Court well in advance of trial and then sit silent until after a verdict is rendered." Appendix E to Petitioner's Brief.

> Court entertained informal objections and suggestions to improve the charge. In fact, [Petitioner] filed written objections to the final proposed charge immediately before the submission to the jury. All objections not contained within the written objections or made on the record during the formal objections stage were not properly submitted to the Court for the purpose of preserving error.
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> * * *
>
> Simply put, Defendant's complaints about the jury charge, aside from lacking merit, were not presented 'in such a manner that the judge could act upon the objection.' *Fischer v. Dallas Fed. Sav. & Loan Ass'n*, 835 F.2d 567, 569 (5th Cir. 1988); FED. R. CIV. P. 51.[7]

Petitioner appealed the judgment of infringement to the United States Court of Appeals for the Federal Circuit. On appeal, Petitioner did not assign error to the "plain meaning" jury instruction, arguing instead that the evidence

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[7] Appendix E to Petitioner's Brief. The district court's holding was in accord with Rule 51, which requires a party to inform the trial judge of deficiencies in the charge in such a manner that the judge can act upon the objection. *McDaniel v. Anheuser-Busch, Inc.*, 987 F.2d 298, 306 (5th Cir. 1993) (citing *Fischer v. Dallas Fed. Sav. & Loan Ass'n.*, 835 F.2d 567, 569-70 (5th Cir. 1988). "[A] pretrial request for instructions or interrogatories is ordinarily insufficient to preserve error; theories of liability and defense frequently change during the course of a trial, and a trial judge will seldom make a final decision regarding the charge until the evidence is complete." *Id.* For this reason, the Fifth Circuit has held that the mere submission of a proposed jury instruction is not sufficiently specific to satisfy Rule 51. *Kelly v. Boeing Petroleum Servs., Inc.*, 61 F.3d 350, 361 (5th Cir. 1995).

was insufficient to prove infringement.[8] The Federal Circuit held oral argument on August 4, 1998, and affirmed without opinion on August 5, 1998, one day after oral argument.

## II. REASONS FOR DENYING THE WRIT

### A. The Federal Circuit Did Not Issue A Published Opinion

This case was decided below on the basis of Driltech's waiver of objections to the jury charge, which incorporated the "plain meaning" claim construction. The Federal Circuit thought so little of the precedential aspects of this case that it affirmed without opinion one day after oral argument. Nor did the district court issue a published opinion in this case.

Because there is no published precedent of any kind related to this case, accepting *certiorari* will not resolve any conflict of published opinions or rectify a published opinion that misstates the law.

### B. Because Of Driltech's Waivers, The Court Will Not Even Reach The Merits of the Issue Advocated By Driltech

Driltech argues that because the district court "instructed the jury to use a 'plain meaning' for a term that [according to Driltech] has a limited meaning in the patent," the district court violated this Court's requirement in *Markman* that the district court interpret claim terms for the jury.[9] This is simply wrong. A "plain meaning"

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[8] This Court will refuse to consider arguments that were not presented to the courts below. *Delta Air Lines, Inc. v. August*, 450 U.S. 346, 362 (1981).

[9] Petitioner's Brief at 19.

construction *is* a claim construction, just not the restrictive one Driltech now wants.

Even if the Court were inclined to grant *certiorari* to address this question, the Court would not reach it because Driltech failed to preserve it. In fact, *Driltech repeatedly urged the district court to use the plain meaning of the claim terms*. Because Driltech actively invited the actions that it now asserts constitute error, there is no arguable basis for the Court to exercise discretionary review.

### C. Driltech Advocates Requiring District Courts To Make *Sua Sponte* Markman Rulings; This Is An Unworkable Precedent

*Markman* provides that district court interpretations of claim terms are reviewed *de novo*. Driltech argues that the district court has a duty to interpret claim terms. In this case, the district court did make a *Markman* ruling: it held the plain meaning of "gate" should control. Driltech is notably silent on what a litigant must do to obtain an interpretation of a claim term that differs from the plain meaning.

Clearly, a litigant cannot sit idle at trial, fail to request a *Markman* ruling on a claim term, then argue on appeal that the district erred by failing to make a *Markman* ruling *sua sponte* as to that claim term. Driltech admits its waiver in its Petition: "[t]he district court, *without objection*, allowed the jury to use the plain meaning of the word 'gate' in reaching its verdict." Petition at 3 (emphasis added). Driltech's posture is *even worse than it admits*: it actually urged the "plain meaning" *Markman* ruling that it now condemns!

Our adversary system of jurisprudence places a duty on the litigants to make requests and lodge objections at the

trial level to preserve arguments on appeal. It is not an onerous burden to require a litigant to timely and properly draw the district court's attention to issues upon which it desires a ruling. The law of waiver regarding jury instructions, Rule 50 motions, and evidentiary objections is well established and critical to the functioning of our adversarial system. Nothing in this Court's jurisprudence even implies that *Markman* rulings should be treated differently.

Modern patent litigation typically involves multiple patents, each with multiple claims. Hundreds, even thousands, of terms can be present in those claims. Any given term can harbor a crucial limitation that can be dispositive of infringement. *Markman* hearings often involve days of testimony from experts and detailed analysis of lengthy prosecution histories to ascribe meaning to one particular term. It would be virtually impossible for the district court to give special definitions for every word in every claim asserted in a patent case. That is why parties must guide the district court's attention to rule upon the meaning of claim terms they consider dispositive.

It must be incumbent upon the parties to identify the disputed terms, to request a *Markman* hearing, and to present proposed definitions. Most importantly, it is incumbent upon the parties to alert the district court to asserted errors in claim construction *before the case is submitted to the jury* so that the district court may consider and have the opportunity to cure any alleged errors in the claim construction. Driltech did none of these things.

In the world that Driltech posits, the parties have none of the above duties. In Driltech's world, a litigant can advocate one meaning at trial and a different meaning on appeal. If this were the law, a litigant would have an

incentive to advocate an erroneous interpretation of a few of the hundreds of claim terms to build in some grounds for automatic reversal. Trial judges across the nation would be forced to undertake the daunting task of *sua sponte* defining every term in a claim for fear of a baited appellate reversal. This Court should reject Driltech's attempt to elevate its flawed world view into procedural law.

### D. Driltech's Attempt To Read Limitations From The Specification Into The Term "Gate" Violates Long-Standing Rules Of Claim Construction

Notwithstanding Driltech's waiver, it is clear that *Markman* does not require any further interpretation of "gate" beyond its plain and ordinary meaning. The plain and ordinary meaning of "gate" is a structure that "opens and closes a recess." Driltech now advocates appending two additional limitations on the term "gate:" 1) that the gate be pivotally attached to the upper arm of the storage rack, and 2) that the gate open and close the recess only when the mast is in a vertical orientation. Neither limitation appears in the claim language, and as will be seen, incorporating these limitations would run afoul of long-standing canons of patent claim construction.

It is a basic tenet of patent law that the language of the claims, not the specification, defines the scope of what the patent covers.[10] It is equally well established that words in a claim should "be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently."[11] If the ordinary meaning of the claim language

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10 *SRI Int'l v. Matushita Elec. Corp.*, 775 F.2d 1107, 1118-19 (Fed. Cir. 1985)*(en banc)*

11 *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 759 (Fed. Cir. 1984).

reads on the accused device (as is the case here), the Court should not limit the claim by reference to the specification.[12] In this case, even if Driltech had not agreed that the plain meaning of the claim terms controlled, the district court still would have been correct to instruct the jury as to the plain meaning of those terms.

The Federal Circuit has, in other cases, condemned the same position that Driltech now advocates. "We have previously stated that '[w]hile . . . claims are to be interpreted in light of the specification and with a view to ascertaining the invention, it does not follow that limitations from the specification may be read into the claims.'"[13] Although the specification may aid the court in interpreting the meaning of disputed claim language, "particular embodiments and examples appearing in the specification will not generally be read into the claims."[14]

The element at issue from Claim 4 of the '135 Patent reads as follows:

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12 *SRI*, 775 F.2d at 119.

13 *Sjolund v. Musland*, 847 F.2d 1573, 1581 (Fed. Cir. 1988); *see Texas Instruments, Inc. v. United States Int'l Trade Comm'n*, 805 F.2d 1558, 1563 (Fed. Cir. 1986)("This court has cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification.").

14 *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571, (Fed. Cir.), *cert. denied*, 488 U.S. 892 (1988) (internal citation omitted); *see Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 865 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1068 (1989) ("References to a preferred embodiment, such as those often present in a specification, are not claim limitations.").

> a storage rack for storing at least one elongated drill pipe section, said storage rack including a lower arm including a receptacle for holding the lower end of a drill pipe section, an upper arm spaced apart from said lower arm, said upper arm including a recess for receiving the upper end portion of a drill pipe section, a movable gate for opening and closing said recess, and power actuator means operable for opening and closing said gate.

The *only* limitation on the term gate expressed in the claim is that the gate must be movable to open and close the recess. The claim is not functionally limited to opening and closing the recess in a particular direction. There is no requirement that the gate be attached to any particular portion of the storage rack. Nor is there any limitation as to whether the mast that holds the storage rack must be vertical or horizontal when the gate closes the recess.

Driltech tries to limit the term gate to a structure that opens and closes the recess when the mast is in a vertical position. Driltech further tries to limit the term gate by requiring that it be attached to the first arm. The claim language does not require either of these limitations, and to limit the term gate in this way would violate the canons of claim construction discussed above.

In a vain attempt to bolster its argument, Driltech points to another structure in the preferred embodiment called "a retainer." Driltech notes that the "retainer" closes the recess when the mast is horizontal and argues that any structure that performs this function cannot be a "gate" because the preferred embodiment of a "gate" closes the recess when the mast is vertical. But, Driltech ignores the portion of specification that identifies the structure Driltech calls the "gate" as a "*retaining gate.*" Thus, the '135 patent

specifies that a gate and retainer perform the same function -- to hold or "retain" a pipe in the recess in one or more directions. Driltech's attempt to differentiate a gate from a retainer is contradicted by the specification, which treats these structures interchangeably.

At trial, Reedrill proved that the Driltech devices contain a structure (that Driltech terms a "latch plate") that moves relative to the storage rack and functions to open and close the recesses in the storage rack. This structure corresponds to the "gate" in Claim 4 of the '135 patent, as it functions to open and close recesses in the upper arm of the storage rack. Reedrill presented persuasive evidence from which the jury could have reasonably concluded that the '135 patent was infringed. All of these technical arguments were raised before and soundly rejected by the Federal Circuit, which found them so unpersuasive that it affirmed the judgment of infringement one day after oral argument.

## III. CONCLUSION

The decision below rested on a "plain meaning" claim construction that Driltech urged and the district court accepted. Just as Driltech cannot assign error to a course of action it invited, this Court should not grant *certiorari* to confirm the long standing legal proposition that one must object at the district court level to preserve the objection for appeal. The Court should deny the writ for these reasons.

November 25, 1998

Respectfully submitted,

Theodore Stevenson, III
*Counsel of Record*
David H. Judson
Danny S. Ashby
HUGHES & LUCE, L.L.P.
1717 Main Street, Suite 2800
Dallas, Texas 75201
(214) 939-5500

ATTORNEYS FOR RESPONDENT